



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited
with the United States Postal Service with sufficient postage as
first class mail in an envelope addressed to: Mail Stop
Appeal Brief, Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450 on March 29, 2007
(Date of Deposit)

Russell E. Fowler II

Name of person mailing Document or Fee

Russ Fowler

Signature

March 29, 2007

Date of Signature

Re: Application of: Jacobs et al.
 Serial No.: 10/609,007
 Filed: June 27, 2003
 For: Valve Calibration Method and Apparatus
 Group Art Unit: 3753
 Examiner: Ramesh Krishnamurthy
 Our Docket No.: 1867-0020
 Siemens Docket No.: 2002P10431US01

TRANSMITTAL OF REPLY BRIEF

Please find for filing in connection with the above patent application the following documents:

1. Reply Brief; and
2. One (1) return post card.

Please charge any deficiency, or credit any overpayment to Deposit Account No.
13-0014.

Respectfully Submitted,
MAGINOT, MOORE & BECK, LLP

A handwritten signature in black ink, appearing to read "Russ Fowler", with a long horizontal flourish extending to the right.

March 29, 2007

Russell E. Fowler II
Registration No. 43,615
Chase Tower
111 Monument Circle, Suite 3250
Indianapolis, IN 46204-5109

Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 29, 2007
(Date of Deposit)

Russell E. Fowler II

Name of person mailing Document or Fee

Russ Fowler

Signature

March 29, 2007

Date of Signature

Re:	Application of:	Jacobs et al.
	Serial No.:	10/609,007
	Filed:	June 27, 2003
	For:	Valve Calibration Method and Apparatus
	Group Art Unit:	3753
	Examiner:	Ramesh Krishnamurthy
	Our Docket No.:	1867-0020
	Siemens Docket No.:	2002P10431US01

REPLY BRIEF

This is a Reply Brief filed in response to the Examiner's Answer mailed January 29, 2007.

I. General Comments

The Examiner's Answer maintains that all of the independent claims 1, 11, 17 and 21 are anticipated by U.S. Patent No. 5,304,903 to Sharp (hereinafter "Sharp").

However, the Examiner's Answer openly admits that Sharp does not teach each and every element *of a single one of those claims*. Instead, the anticipation rejections rely on disregarding several limitations and/or teachings by "inherency". In particular, the Examiner *now* maintains that the limitations of the processor in claims 1 and 21 are merely functional, and thus the processor in Sharp satisfies those limitations without actually disclosing them. (Examiner's Answer at p.4). With regard to method claims 11 and 17, various shortcomings of Sharp are glossed over with unsupported and incorrect inherency arguments.

Nowhere does the Examiner identify a single independent claim in which each element is disclosed in Sharp. As will be discussed below, neither the disregarding of limitations nor the inherency arguments are proper. As a consequence, the anticipation rejection of independent claims 1, 11, 17 and 21 should be reversed. Moreover, for reasons set forth in the Appeal Brief, the rejections of all claims should be reversed.

II. Claim 1

The Examiner appears to admit that Sharp fails to teach the literal limitations of the processor of claim 1. In particular, in Applicant's Appeal Brief, it was asserted that the the Sharp fails to teach a processor that is operable to: "provide a plurality of voltage to an actuator..., receive from a source of flow measurements a flow measure..., and

store information representative of the relationship between [the voltages and flow measures].”

In the Examiner’s Answer, the Examiner did not attempt to rebut this argument by stating where and how the processing circuit of Sharp performs such operations. Instead, the Examiner stated:

Applicant is arguing that Sharp et al. fails to disclose a processing circuit that performs the calibration operations of claim 1. In response, it is noted that Sharp et al. does indeed disclose a processing circuit (55) and the alleged calibration operations of claim 1 have been recited in the form of functional limitations **ONLY** that the processing circuit (55) is certainly capable of performing and hence the anticipation of the claimed limitations by Sharp et al. as set forth in the Final office action is proper.

(Examiner’s Answer at p.4).

Thus, the issue is not whether Sharp teaches the literal elements of claim 1, but rather whether Sharp teaches a device that *is capable of performing* claimed “functional limitations.”

A. The Examiner has not Established a Prima Facie Case

The Examiner states that the processing circuit 55 of Sharp “is certainly capable of performing” the “functional limitations” of claim 1. There is no evidence on the record that the processing circuit is capable of “[receiving] from the source of flow measurements a flow measure..., and [storing] information representative of the relationship between each of the plurality of voltages and the flow measures”.

By way of example, the processing circuit of Sharp is completely incapable of receiving flow measurements because it is not connected, nor disclosed to be connectable to, a source of flow measurements. Further, there is nothing to indicate that the processor 55 of Sharp is programmed or otherwise configured to perform the claimed operations.

B. The Examiner's Discounting of "Functional Limitations"

Even if the processing circuit 55 were modifiable to perform the claim limitations of claim 1, it is improper to equate the possibility of modification to perform claimed operations with an anticipatory teaching.

More specifically, the Examiner appears to rely on the argument that because claim 1 recites a processing circuit "operable to" perform certain operations, that virtually any processing circuit satisfies those limitations. This is incorrect. For a processing circuit to be *operable* to perform certain operations, it must be *programmed and/or otherwise configured* to receive certain inputs and perform those operations. If the processing circuit is not *in fact* programmed or otherwise configured to perform the claimed operations, *it is not operable to perform those operations*.

Thus, the mere fact that the processing circuit 55 of Sharp arguably *could be programmed* to perform the claimed operations, and to receive the inputs as claimed, is not enough to satisfy the limitation that the processing circuit 55 of Sharp is *operable* to perform those operations, absent the programming.

For this additional reason, the rejection of claim 1 should be reversed.

C. Late Notice

The Examiner first advanced the "merely functional" limitation argument in the Examiner's Answer. This implies that the Examiner would have withdrawn this rejection if the applicant had replaced "operable to" with "configured to" or "programmed to" or some other language during prosecution. Because this argument was first advanced in the Examiner's Answer, applicant did not have this opportunity. Applicant certainly did

not claim the alleged “functional limitations” with the expectation that they would be discounted through use of the words “operable to”.

III. Claim 21

The arguments set forth above in connection with claim 1 apply to claim 21.

IV. Claim 11

The Examiner’s Answer acknowledges, effectively, that the calibration operation of Sharp must occur *in situ*, or in other words, after installation in the facility in which the device will be used, in order to satisfy the elements of claim 11. To this end, the Examiner’s Answer asserts that the “calibration operation” of Sharp must inherently be performed *in situ*. (Examiner’s Answer at p.5). Thus, the rejection of claim 11 would be appropriately withheld, according to the Examiner.

To support the *in situ* calibration assertion, the Examiner states that the “since the calibration curve is being utilized to position the valve to produce the desired flow, such calibration necessarily refers to “in-situ” calibration.” (*Id.*)

The Examiner is incorrect. Calibration of valve position versus flow in a Venturi Valve does not need to be performed *in situ*. There is absolutely no reason why the flow versus position curve cannot be calibrated at a manufacturing facility, or within a dedicated calibration fixture.

Thus, *in situ* calibration of Venturi valves is *not* the only possibility. As a consequence, inherency with regard to this issue is unsupported. While *in situ* calibration

of a Venturi valve is a possibility, the lack of a suitable *in situ* flow sensor in Sharp indicates that the calibration is performed elsewhere.

Because the Examiner has failed to support a case of inherency with respect to the calibration operation of Sharp occurring *in situ*, it is respectfully submitted that the anticipation rejection of claim 11 is in error and should be reversed.

V. Claim 17

With regard to claim 17, applicant does not believe the Examiner's Answer has successfully rebutted that arguments set forth in connection with claim 17 in the Appeal Brief.

VI. CONCLUSION

For all of the foregoing reasons, as well as those set forth in the Appeal Brief, claims 1-26 are not unpatentable. As a consequence, the Board of Appeals is respectfully requested to reverse the rejection of these claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Russ Fowler", with a long, sweeping horizontal line extending to the right.

March 29, 2007

Russell E. Fowler II
Attorney for Applicants
Attorney Registration No. 43,615
Maginot Moore & Beck
Chase Tower
111 Monument Circle, Suite 3250
Indianapolis, Indiana 46204-5109
Telephone: (317) 638-2922